

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, tentatively rejected all claims 1-8 under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of U.S. Patent 6,211,613 to May in view of U.S. Patent 6,247,820 to Van Order. No claims are amended and claims 1-8 remain pending in this application. For at least the reasons set forth below, Applicants respectfully traverse the rejections and request reconsideration of the claims.

Rejection to claim 1

Independent claim 1 stands rejected under 35 U.S.C. 103(a) as allegedly unpatentable over *May* in view of the *Van Order*. *May* appears to disclose an electroluminescent display of high contrast and *Van Order* apparently discloses an electro-optic mirror with contrasting display. As described in col. 1, lines 1-3, the electro-optic mirror with contrasting display of *Van Order* is related to an electro-optic display system that is especially useful for mirrors in an automotive vehicle environment.

All embodiment disclosed in *Van Order* relate to an electro-optic mirror used in an automobile, but not a display of self-luminance capability as the organic electroluminescent display of the present application.

Consequently, Applicant *May* and *Van Order* are not-analogous art and therefore cannot be combined properly.

In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore &*

Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create an electroluminescent display as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50

USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was is motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *Gambro Lundia AB*, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, No 98-1553 (Fed. Cir. January 27, 2000). Well-established Federal Circuit case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Evidence of teaching or suggestion is “essential” to avoid hindsight. *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988). A description of the particular “teaching or suggestion or motivation [to combine]” is an “essential evidentiary component of an obviousness holding.” *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed.Cir.1998). Indeed, in forming an obviousness type rejection, “the [Examiner] must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them.” *In re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998). The Examiner can satisfy this burden of establishing obviousness in light of

combination "only by showing some objective teaching [leading to the combination]." In re Fritch, 972 F.2d 1260, 1265 (Fed.Cir.1992).

The mere fact that a reference teaches away from the combination with another reference is sufficient to defeat an obviousness claim. See Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383. A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

As set forth above, the May and Van Order references actually teach away from a combination. Significantly, however, the Office Action has no advantage for the combination of Van Order with May. In fact, the only motivation at all alleged by the Office Action is that the combination of Van Order with May allegedly "allows to keep a high contrast of display image regardless of ambient light intensity." Applicant submits that, even if true, this is an irrelevant motivation in the context of the current language of claim 1.

For at least the foregoing reasons, independent claim 1 patently defines over the cited art of record. Claims 2-8 depend from claim 1 and add further limitations. It is respectfully submitted that these dependent claims are allowable by reason of depending from an allowable claim as well as for adding further limitations.

Therefore, Applicant respectfully submits that the rejection can be withdrawn and requests that a timely Notice of Allowance be issued in this case.

Cited Art

The cited art made of record, but not relied upon, has been considered but is not believed to impact the patentability of the pending claims.


CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this Response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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